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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,315	02/16/2001	Taeyoung Yoon	49563-1 (72021)	7054
21874	7590	06/16/2004	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			LIU, HONG	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 06/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/788,315	Applicant(s) YOON ET AL.	
	Examiner Hong Liu	Art Unit 1624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 6,8,10-15,30 and 42.

Claim(s) rejected: 3-5,7 and 9.

Claim(s) withdrawn from consideration: 16-26,43-130,133-146,154,155 and 162.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

The after final arguments filed on 05/03/04 have been fully considered but they are not persuasive. Applicants argued that the compounds of Hori have a benzyl substitute at the R1 position whereas R1 of the instant compounds does not have the definition of a benzyl group. Although R1 is not explicitly defined to be benzyl, R1 group, as defined, could contain a benzyl substitution. This is because R1 can be C1-C3 alkyl which can be further substituted by phenyl according to the definition of alkyl on page 26 of the specification. The definition of R1 on page 26 specifically teaches that one of the R1 substituents can be phenyl. A methyl substituted by phenyl constitutes a benzyl group. Consequently, contrary to applicants' assertion that R1 cannot be benzyl, R1 can be a benzyl when R1 is alkyl substituted by phenyl.

Applicants' arguments that that definition of R1 on page 26 only applies to the part of the specification prior to page 26 because of the phrase "as indicated above" on page 26 and that it does not apply to the claims because the claims appear on page 166 are equally unpersuasive. It is well settled that claims of patents are to be interpreted in light of the specification. As long as there is relevant definition for a certain variable in the specification, it can serve as the definition of the same variable in the claim no matter where it appears in the specification. To reason otherwise, as applicants' arguments suggest, would mean that the specification can never be used to interpret the claim because it always appears on pages before the pages of the claims. Applicants are also reminded that during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be

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given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir.1989); MSM Investments Co. v. Carolwood Corp., 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001). The plain meaning of alkyl is that it can be substituted alkyl or unsubstituted alkyl. Absent the teaching in applicants' specification that R1 can only be unsubstituted alkyl, one should interpret alkyl to mean both substituted and unsubstituted. Because applicants' arguments are not deemed to be persuasive, this application cannot be placed in condition of allowance at this stage.


Applicants are reminded that entry of amendment after final rejection is not a matter of right. "Except where an amendment merely cancels claims, adopts examiner suggestions, remove issues for appeal, or is some other way only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final reelection." See MPEP 714.13. For these reasons, this amendment after final rejection will not be entered.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (571) 272-0669. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisors, Mukund Shah can be reached at (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 358-1235.


RICHARD L. DIAMOND
PHOTOGRAPHER
Mukund Shah
Supervisory Patent Examiner
Art Unit 1624

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June 10, 2004